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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,344	09/24/2001	Tamae Hashimoto	Q66385	4620

7590 08/09/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue N.W.
Washington, DC 20037-3202

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,344

Applicant(s)

HASHIMOTO, TAMAE

Examiner

Victor Lesniewski

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RD

DETAILED ACTION

1. The amendment filed 5/9/2005 has been placed of record in the file.
2. Claims 8 and 9 have been added.
3. Claims 1-9 are now pending.
4. The applicant's arguments with respect to claims 1-7 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

Claim Rejections

5. Claims 1, 2, and 4-6 remain rejected under 35 U.S.C. 102(b) as being anticipated by Reifman et al. (U.S. Patent Number 5,917,615), hereinafter referred to as Reifman, as stated in the office action mailed 2/9/2005. Claims 3 and 7 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Reifman as stated in the office action mailed 2/9/2005.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Reifman.
8. Reifman has disclosed:

Art Unit: 2152

- <Claim 8>

A document transmission apparatus as claimed in claim 1, wherein a user selects the additional information to insert into said transmittal letter (column 21, lines 33-45).

- <Claim 9>

A storage medium as claimed in claim 5, wherein a user selects an arbitrary one of the pieces of additional information to insert into said transmittal letter (column 21, lines 33-45).

Since all the limitations of the invention as set forth in claims 8 and 9 were disclosed by Reifman, claims 8 and 9 are rejected.

Response to Arguments

9. In the remarks, the applicant has argued:

- <Argument 1>

Reifman does not disclose the features of claim 1 because he does not disclose “selecting an arbitrary one of the pieces of additional information from with said additional storage section” and “producing a transmittal letter in which the additional information selected by said operation is inserted” as recited in claim 1.

- <Argument 2>

Reifman does not disclose the features of claim 2 because he does not disclose “displaying the additional information stored in said additional information storage section” as recited in claim 2.

- <Argument 3>

Reifman does not disclose the features of claim 3 because he does not disclose “a registration number and a title for each of the pieces of additional information” as recited in claim 3.

10. In response to argument 1, Reifman does disclose the features as recited in claim 1. It can be seen that Reifman’s data files meet the claimed limitations for “additional information.” The previous line citations to column 21, lines 24-45 show the ability of a user in Reifman’s system to enclose a data file with a message. The user selects a file to enclose from a folder in its file storage unit (ie. “additional information storage section”) and the file is enclosed (or “inserted”) into the message.

11. It is noted that the applicant has stated that Reifman does not teach “an operation section which selects an arbitrary one of pieces of additional information” when in fact this is not a limitation of the claim in question. Claim 1 states “an operation section for selecting an arbitrary one of pieces of additional information.” Also, the applicant refers to Reifman’s “filling in” of information on a cover page in relation to the claimed “additional information” when in fact it is the data file that meets this limitation. Additionally, the applicant refers to the selection of a cover page in Reifman in relation to inserting additional information into a letter. Here, again, the applicant has mischaracterized the rejection. Enclosing or attaching a data file in the message meets the inserting limitation as claimed.

12. In response to argument 2, Reifman does disclose the features as recited in claim 2. Since it can be seen that the data files of Reifman’s system are analogous to the claimed “additional information,” it can also be seen that these files are displayed to the user so that the

Art Unit: 2152

user may select a file to enclose. This display section meets the limitations of claim 2 as it does display the files stored in the file storage unit. The applicant has stated that “Reifman only displays the names of the files listed, and not information stored.” However the claim makes no reference to any properties or specific data of the “additional information” that would be displayed. Thus, displaying the data file itself (ie. “additional information”) to the user meets the limitations of the claim.

13. In response to argument 3, Reifman does disclose the features as recited in claim 3 in view of obviousness. As previously stated, it would be a clear extension of Reifman’s system to use a registration number to represent each data file in addition to the title. It has already been seen that the system stores a title for each file, thus it would have been obvious to store the registration number in addition. Similarly, it has been seen that the system displays the titles in a list, thus it would have been obvious to also display registration numbers. Moreover, it would have been obvious to use the registration number to select the file, since it has already been seen that the files can be chosen by title. Reasons for obviously using a registration number in addition to a title have been given in the previous action mailed 2/9/2005. (See paragraphs 9 and 10.) In short, it would be a clear extension of the system to use a registration number since the system already uses titles to label each file. A number is an alternate way in which to label such files and the use of alternative labeling methods is well known. Thus it would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to utilize a registration number in Reifman’s system. As discussed above in this paragraph, it would be obvious to utilize the registration numbers in the system in the same way in which Reifman utilizes titles of files.

Art Unit: 2152

14. The applicant has also stated that conclusions as to the advantages of using registration numbers are based upon improper hindsight reasoning. In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is maintained that the use of registration numbers in such a system as Reifman's was well within the level of ordinary skill at the time of the claimed invention.

15. In addition, the applicant has argued that claims rejected under 35 U.S.C. 102 and 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

Conclusion

16. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2152

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

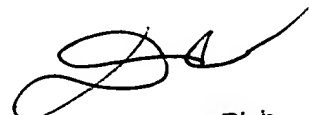
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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